

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

SCOTT SCHMEIZER and TKS INT'L, LLC,

Plaintiffs-Counterclaim Defendant,

CASE NO. 2:17-cv-04966-GRB

v.

RAFFAELE IANNELLO,

**FINAL JUDGMENT ENFORCING
FOREIGN ARBITRATION AWARD**

Defendant-Counterclaim Plaintiff.

/

FINAL JUDGMENT ENFORCING FOREIGN ARBITRATION AWARD

THIS MATTER came before this Court on Counter-Plaintiff's, RAFFAELE IANNELLO, motion for an order enforcing the foreign arbitration award issued by the sole arbitrator Federica Oronzo in Rome, Italy, on March 22, 2016, in the arbitration proceedings between RAFFAELE IANNELLO and TKS INT'L, LLC, an authenticated and translated copy of which is attached hereto as **Exhibit A** (hereinafter referred to as the "Arbitration Award"). On July 3, 2018, this Court issued a Memorandum of Decision & Order granting Counter-Plaintiff's, RAFFAELE IANNELLO, Motion to Enforce Foreign Arbitration Award (the "Order"). Under the Order, which is hereby confirmed and incorporated, pursuant to Fed. R. Civ. Pro. 58, this Court now enters this Final Judgment Enforcing Foreign Arbitration Award, to render the Arbitration Award immediately enforceable and executive as a judgment under the Federal Rules of Civil Procedures:

1. **THEREFORE, IT IS ORDERED AND ADJUGED** that the Arbitration Award attached to this Order is confirmed in all respects and that the Arbitration Award shall be enforced, for which let execution issue forthwith.

2. **IT IS FURTHER DECLARED** that RAFFAELE IANNELLO owns all rights, titles, and interests, in the marks "RAFFAELE IANNELLO," "RICSB," "RAFFAELE IANNELLO CREATIVE SOUL BRAND," "VOODOO," "VOODOO/THE EX," "THE EX" and

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in all trademarks, patents, trade dresses, designs, copyrights, and any other intellectual property rights in the product identified in **Exhibit B** (hereinafter the “Product”) and in all trademarks, patents, trade dresses, designs, copyrights, and any other intellectual property rights TKS INT’L, LLC used or registered under the licensing agreement between the parties (hereinafter the “Licensing Agreement”).¹ The rights, titles, and interests, mentioned above include, but are not limited, to the followings:

	<i>Intellectual Property Type</i>	<i>Name/Image</i>	<i>Goods and Services Type</i>	<i>Registration No.</i>
(a)	United States Trademark	“THE EX”	Cutlery	US Registration Number No. 3226398
(b)	United States Trademark		Cutlery	US Registration Number No. 3226399
(c)	United States Trademark	“THE EX”	Pens and pen holders	US Registration Number No. 3940656
(d)	United States Trademark	“VOODOO”	Knife blocks	US Registration Number No. 3480089
(e)	United States Trademark	“VOODOO”	Pens and pen holders	US Registration Number No. 4053966

1. The Licensing Agreement was originally entered between RAFFAELE IANNELLO and C.S.B. COMMODITIES, INC on July 1, 2017. C.S.B. COMMODITIES, INC assigned its rights under the Licensing Agreement to TKS INT’L, LLC on September 12, 2011. *See generally* DE 30-3. and DE 30-4.

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(f)	United States 3D Trademark		Knife blocks	US Registration Number No. 3480124
(g)	United States Trademark	“FIVE FINGER FILLET”	Knife holders/ Knife blocks	US Registration Number No. 3775376
(H)	United States Patent	“MAGNETIC KNIFE STAND”	N/A	Patent No. US 2006/0289701
(i)	United States Patent	“MAGNETIC KNIFE STAND”	N/A	Patent No. US 7,422,180 B2
(j)	United States Copyright	“THE VOODOO”	N/A	Registration No. VA0001730824

3. **IT IS FURTHER ORDERED** that, by operation of law, the United States Patent and Trademark Office shall transfer any and all trademarks and patents used or registered under the Licensing Agreement between the parties to RAFFAELE IANELLO, including, but not limited to, the trademarks and patents that are referred in paragraph 2 of this Order. In this regard, TKS INT'L, LLC shall assign to RAFFAELE IANNELLO, at TKS INT'L, LLC's sole expenses, all trademarks and patents used or registered under the Licensing Agreement between the parties including, but not limited to, the trademarks and patents that are referred in paragraph 2 of this Order. TKS INT'L, LLC shall compile, execute, and file with the United States Patent and Trademark Office the Assignment Recordation forms PT0-1594 and PTO-1595 attached hereto as **Exhibit C** within seven (7) days from the date of this Order. TKS INT'L, LLC shall file an affidavit of compliance within seven (7) days from the date of filing the attached Assignment Recordation forms.

4. **IT IS FURTHER ORDERED** that, by operation of law, the United States Copyright Office shall transfer any and all copyrights TKS INT'L, LLC registered under the licensing agreement between the parties to RAFFAELE IANNELLO, including, but not limited to, the copyright referred in paragraph 2 of this Order. In addition, TKS INT'L, LLC shall assign to RAFFAELE IANNELLO, at TKS INT'L, LLC's sole expenses, all the all copyrights registered or used under the licensing agreement between the parties including, but not limited to, the copyright referred in paragraph 2 of this Order within seven (7) days from the date of this Order. TKS INT'L, LLC shall file an affidavit of compliance within seven (7) days from the date of the assignment.

5. **IT IS FURTHER ORDERED** that TKS INT'L, LLC shall assign to RAFFAELE IANNELLO, at TKS INT'L, LLC's sole expenses, all the domain names incorporating or using in any manner the tradenames that are referred in paragraph 2 of this Order including, but not limited to, the followings: www.ricsb.com, www.ricsb.co.uk, www.ricsb.com, www.gettheex.com, www.theknife.com, www.voodooknife.com, www.facebook.com/TheExKnife, www.twitter.com/theexknife, www.pinterest.com/theknife, www.youtube.com/theExknife within seven (7) days from the date of this Order. TKS INT'L, LLC shall file an affidavit of compliance within seven (7) days from the date of the assignment.

6. **IT IS FURTHER ORDERED** that TKS INT'L, LLC along with its manager, members, officers, principals, agent, representatives, servants, employees, affiliates, successors or assigns, and any person or entity acting on its behalf or in concert or participation with it, is **PERMANENTLY ENJOINED** from manufacturing or causing to be manufactured, importing, advertising or promoting, distributing, selling or offering to sell:

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- (a) Any product, item or package that embodies, depicts in whole or in part, or incorporates or uses in any manner any of the intellectual property rights that are referred in paragraph 2 of this Order; and
- (b) Any product, item or packaging that embodies, depicts in whole or in part, or incorporates or uses in any manner the design or appearance of the Product or any other products or items TKS INT'L, LLC produced, manufactured, sold, advertised or distributed under the Licensing Agreement.

7. **IT IS FURTHER ORDERED** that TKS INT'L, LLC along with its manager, members, officers, principals, agent, representatives, servants, employees, affiliates, successors or assigns, and any person or entity acting on its behalf or in concert or participation with it, are further hereby **PERMANENTLY ENJOINED** from engaging in any of the following acts:

- (a) Engaging in any infringement of any patents, trademarks, trade dresses, designs copyrights, or any other intellectual property rights that are referred in paragraph 2 of this Order;
- (b) Asserting any ownership of rights or any right, titles or interests in the trademarks, patents, trade dresses, designs, copyrights, and any other intellectual property rights that are referred in paragraph 2 of this Order;
- (c) Using the domain names incorporating or using in any manner the tradenames that are referred in paragraph 2 of this Order including, but not limited to, the followings: www.ricsb.com, www.ricsb.co.uk., www.ricsb.com, www.gettheex.com, www.theknife.com, www.voodooknife.com, www.facebook.com/TheExKnife, www.twitter.com/theexknife, www.pinterest.com/theknife, www.youtube.com/theExknife.
- (d) Assisting, aiding, or abetting any other entity or person in engaging in or performing any of the activities referred to in the paragraphs 7(a), 7(b), and 7(c) above and in paragraphs 8(a), 8(b), and 8(c) above.

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8. **IT IS FURTHER ORDERED** that, at TKS INT'L, LLC's sole expenses, TKS INT'L, LLC shall deliver to RAFFAELE IANNELLO's counsel for impoundment, at such location as RAFFAELE IANNELLO's counsel may direct, all Products, items, or packages that embodies, depicts in whole or in part, or incorporates or uses in any manner any intellectual property rights that are referred in paragraph 2 of this Order together with all plate, molds, matrices and other means of making the same, in the direct or indirect possession, custody or control of TKS INT'L, LLC, its manager, members, officers, principals, agent, representatives, servants, employees, affiliates, successors or assigns, and any person or entity acting on its behalf or in concert or participation with it. RAFFAELE IANNELLO's counsel is hereby appointed substituted custodian for all such items.

9. **IT IS FURTHER ORDERED** that, at TKS INT'L, LLC's sole expenses, TKS INT'L, LLC shall procure the return, and to withdraw and recall, from any and all channels of trade and distribution, including without limitation from retail shelves and from online retailers, all of the Products, items, or packages that embodies, depicts in whole or in part, or incorporates or uses in any manner any intellectual property rights that are referred in paragraph 2 of this Order. In the event that any additional Products, items, or packages subject to this Order is subsequently delivered to or comes within the direct or indirect possession, custody or control of TKS INT'L, LLC, TKS INT'L, LLC shall promptly deliver the additional Products or items to RAFFAELE IANNELLO's counsel, which is hereby appointed substituted custodian for all such items. As to each entity or person returning the Products or item, TKS INT'L, LLC shall refund all monies paid by each entity or person in connection with such Products or items and shall reimburse the entity or person for all associated shipping charges.

To the extent that recall is not feasible, TKS shall inform third-party vendors that sale of any such products would be in violation of law. Such communications shall be in writing, with copies supplied to Iannello's counsel, as set forth in ¶ 11.

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10. **IT IS FURTHER ORDERED** that TKS INT'L, LLC shall serve upon RAFFAELE IANNELLO's counsel within twenty (20) days from the date of this Order an affidavit, made under oath, that sets forth fully and completely the following information: (a) the identity of each and any Product, item, or packages that embodies, depicts in whole or in part, or incorporates or uses in any manner any intellectual property rights that are referred in paragraph 2 of this Order; (b) for each Product, item, or package the number of units manufactured, marketed, displayed, distributed, shipped, imported, exported, sold or offered for sale by TKS INT'L, LLC or its agents; (c) for each unit of Product, item or package, the purchaser, transferee or recipient of each unit(s), the quantities acquired by purchaser, transferee or recipient and complete contact information (including limitation the address, telephone number, fax number and email address where known) for each such purchaser, transferee or recipient; (d) for each unit of the Product, item, or package the current or last known location of each such unit, including without limitation

the location of all Products, or provide access to records & documents detailing such information

11. **IT IS FURTHER ORDERED** that at TKS INT'L, LLC's sole expense, TKS

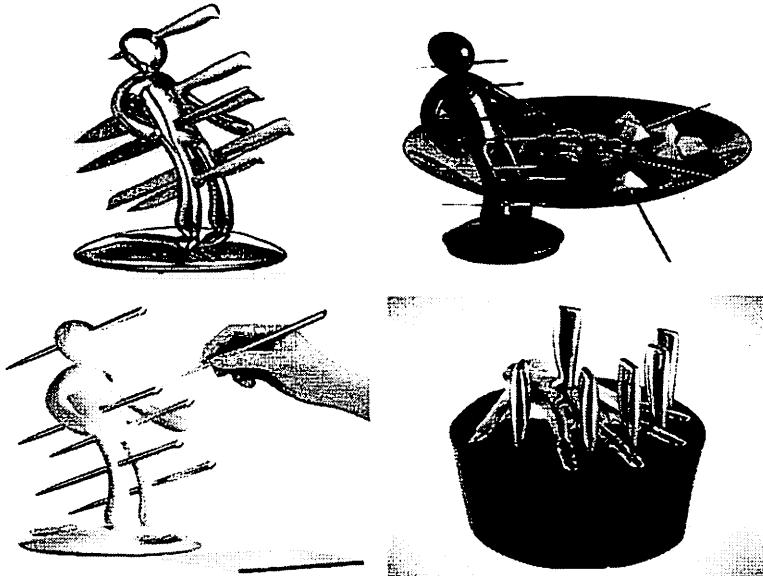
INT'L, LLC shall make written contact (either through fax or electronic mail) with (i) each retailer, distributor, wholesaler, importer, exporter, customer, licensee or any other person and entity to or through whom TKS INT'L, LLC has shipped, transferred, imported, exported or sold any Products or other items that are the subject of this Order; and (ii) each retailer, distributor, wholesaler, licensee, potential licensee, customer, potential customer or any other person and entity who TKS INT'L, LLC has contacted (whether by mail, electronic mail, orally or otherwise) since March 22, 2016, for marketing, promoting or advertising any Product or other item that is the subject of this Order, and shall provide each person and entity with a copy of this Order and with a verbatim copy of the following notice, in legible and conspicuous print, in its entirety:

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NOTICE PUBLISHED PURSUANT TO
ORDER OF THE UNITED STATES DISTRICT COURT

YOU ARE HEREBY ADVISED as follows:

In the last two years, you might have bought, seen, or contacted regarding, the sale of these products:



which have been sold and marketed as the Ex Knife holder / Voodoo Knife block, the Ex Knife pen holder / Voodoo pen holder, the Ex Knife tray / Voodoo tray, and the Five Finger Fillet knife holder (the "Products").

Pursuant to the ruling of the United States District Court recognizing an Italian arbitration award, RAFFAELE IANNELLO is the owner of all the trademarks, patents, and copyrights related to the Products ("intellectual property"). Under the ruling, RAFFAELE IANNELLO's intellectual property was infringed by identical or similar products sold by TKS INT'L, LLC and its affiliates.

The Court has ordered TKS INT'L, LLC to immediately cease any further manufacture, sale, promotion, shipment or distribution of the Products.

If you are a vendor of the Products, this Court has ordered that all profits from the Product that you would have otherwise returned to TKS INT'L, LLC must be returned to counsel for RAFFAELE IANNELLO at the following address: 3650 NW 82nd Avenue, Suite 401, Doral, Florida 33166, who can be contacted at service@anmpa.com.

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12. **IT IS FURTHER ORDERED** that within sixty (60) calendar days of the date of this Order, TKS INT'L, LLC will file with the Court, and personally serve on RAFFAELE IANNELLO's counsel, an affidavit of compliance under oath setting forth the actions taken to comply with the terms of paragraphs 8, 9, 10, and 11 of this Order. Specifically, this affidavit shall have attached each communication ordered to be sent pursuant to paragraph 12 of this Order.

13. **IT IS FURTHER ORDERED** that TKS INT'L, LLC, a Delaware company with a last known address of 2501 Riverside Drive, Wantagh, New York 11793-4543 pay to RAFFAELE IANNELLO, with an address of 3650 NW 82nd Avenue, Suite 401, Doral, Florida 33166, the following amounts for which let execution issue forthwith:²

- (a) The arbitral award in the sum of **\$160,150.68**;
- (b) Attorneys' fees and costs incurred by RAFFAELE IANNELLO during the arbitration proceedings as follows:

<i>Item</i>	<i>Amount in EUR</i>	<i>Amount in USD as for March 22, 2016</i>
Attorneys' Fees	€8,502.00	\$9,552.00
General Expenses under art. 13 of D.M. 55/2014 (It.). ³	€1,275.30	\$1,575.00
<i>Cassa Previdenziale Avvocati</i> ("CPA") (i.e., National Lawyers Fund)	€391.09	\$439.40
Taxable Amount	€10,168.39	\$11,556.40
VAT at 22%	€2,237.05	\$2,554.61

2. In an action to enforce an arbitration award under the New York Convention, the proper date for converting the arbitration award from a foreign currency to U.S. dollars is the date of the arbitration award. *Yukos Capital S.A.R.L. v. Samaraneftegaz*, 592 Fed. Appx. 8, 12 (2d Cir. 2014); 9 U.S.C.A. § 207. Here, because the Arbitration Award was entered on March 22, 2016, and some of the Award's amounts are expressed in Euro, the exchange rate applied to this Order is the average exchange rate on March 22, 2016, i.e., 1 EUR = 1.1235 USD. <https://www.poundsterlinglive.com/best-exchange-rates/euro-to-us-dollar-exchange-rate-on-2016-03-22>

- 3. This is a flat 15% of the attorneys' fees total amount.

Total	€12,405.44	\$14,111.01
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(c) The arbitrator's fees and costs as follows:

<i>Item</i>	<i>Amount in EUR</i>	<i>Amount in USD as for March 22, 2016</i>
Arbitrator's Fees	€13,803.60	\$15,508.35
General Expenses under art. 13 of D.M. 55/2014 (It.).	€2,070.54	\$2,326.25
<i>Cassa Previdenziale Avvocati</i> ("CPA") (i.e., National Lawyers Fund)	€391.09	\$439.39
Non-exempt costs	€1,500.00	\$1685.25
Taxable Amount	€18,069.11	\$19,959.24
VAT at 22%	€3,975.25	\$4,391.03
Total	€22,044.31	\$24,350.27

All the sums above shall bear nine percent (9%) post-judgment interest from March 22, 2016.⁴

14. **IT IS FURTHER ORDERED** that this Court shall have jurisdiction to interpret and enforce the terms of this Order and to determine any issues which may arise concerning this Order, including an award of attorneys' fees and costs to Iannello.

IT IS SO ORDERED AND ADJUGED.

Dated: Central Islip, New York, September 28, 2018.

/s/ Gary R. Brown

GARY R. BROWN
United States Magistrate Judge

4. On enforcement of German arbitration award, holder of award was entitled to interest computed at rate allowed by German tribunal from date of breach until date of award and thereafter at rate allowed by New York law. *Von Engelbrechten v Galvanoni & Nevy Bros., Inc.*, 59 Misc 2d 721, 724 [Civ Ct 1969], affd, 61 Misc 2d 959 [App Term 1970]. Here, RAFFELE IANNELLO is not seeking pre-judgment/award interest, but only post-judgment/award interest.